

Applicant: Blodgett
Serial No.: 10/766,267

PATENT
Atty Docket: 18393-512

Remarks/Arguments

This Amendment is filed in response to the Final Office Action mailed March 8, 2005. In this Amendment, claims 1-26 are unchanged. No amendments have been made and no new claims have been added. Claims 1-26 are pending in this application.

In the Office Action, claims 1-26 are rejected on prior art grounds. However, it is submitted that this response places all claims into condition for allowance and thus that entry of this Response is proper.

Previously Submitted Declaration Under 37 CFR 1.131

In the Applicant's Amendment and Response to Office Action mailed January 19, 2005, the applicant provided a declaration under 37 CFR 1.131 to swear behind the *McManus et al.* application (U.S. Publication No. 2002/0084664). However, it appears that the exhibit label tabs were either removed or obstructed during scanning by the USPTO scanning operators. This administrative anomaly appears to have been a primary reason that led the Examiner to reject the declaration. And in doing so, the Examiner raised five points. These points are addressed below.

In the first point, the Examiner asserted that the declaration lacked Exhibits 1-4. The declaration did, however, contain Exhibits 1-4. They were apparently simply not recognizable as such due to the scanning problems at the USPTO as noted above. To address this issue, newly labeled Exhibits 1-4 are presented. Specifically, Exhibit 1 includes 4 pages, Exhibit 2 includes 1 page, Exhibit 3 includes 2 pages and exhibit 4 includes 2 pages.

The Examiner presented a second point that there is "no nexus between the alleged fax, which cover page is not identified with the invention in any manner, and the attached pages which have no date and no indication that they

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were, in fact, faxed on the alleged date". However, it is submitted that the fax cover page (Exhibit 1, pg 1) does have a nexus with the remaining fax pages (Exhibit 1, pgs 2-4) describing the invention of the present application.

First, as seen in paragraphs 9 and 10 of the Supplemental Declaration of Raymond Blodgett, Jr. Under 37 C.F.R Section 1.131 (Supplemental Declaration), the inventor of the present invention, Raymond Blodgett, Jr. stated that all pages shown in Exhibit 1 were faxed on or about February 4, 2000 from Larry Revelino, an employee of RBW, to Ronald Tamura of the law firm of Oppenheimer Wolff & Donnelly LLP.

Further, the fax pages themselves corroborate the nexus between the fax pages and date of transmission as stated in the Supplemental Declaration. The fax machine used to transmit Exhibit 1, like most fax machines, included each of the following items on the transmitted page: the date and time of transmission, the name of the transmitter, the page number, and the transmitter's fax number. As can be seen on the top of pages 2-4, the date "Feb 04 00" was printed, along with the RBW name and fax number, corroborating that Exhibit 1 was sent on February 4th, 2000, as declared in the Supplemental Declaration.

In a third point, the Examiner states that "there is no indication that the alleged product quote is identified in any manner with the invention of dual rail slide out support". However, as described in paragraphs 13 and 14 of the Supplemental Declaration and seen in Exhibit 2, the "Requirement Summary" section is for a "Low profile, slide out system - Powered." "Low profile" is the designation used for the present invention internally within RBW because using a first support rail and a second support rail connected to each other (as claimed) allows the slide-out to have a "low profile."

Additionally, the "Product Recommendation" of Exhibit 2 includes the text "LPS-20504." As stated in paragraph 10 of the Supplemental Declaration, the "LPS" of "LPS-20504" is an acronym used at RBW for "Low Profile Slide-out" as

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discussed above. Thus, these elements of Exhibit 2 corroborate the declarations of the Supplemental Declaration that this product quote was for a slide-out system of the present invention that was actually reduced to practice.

In a fourth point, the Examiner states that there is "no indication that the 3rd page set was a draft of the patent application, and no indication that the final draft cover letter is associated with the invention of this application". However, as described in paragraphs 15 and 16 of the Supplemental Declaration, the letters of Exhibit 3 and Exhibit 4 reference attorney docket number 18393-12. This number is the attorney docket number for the application of which the present application is a direct continuation application under 37 C.F.R. Section 1.53(b), i.e. it is the attorney docket number for the parent application. This can be confirmed by viewing the PAIR screen for the parent application (U.S. Application Serial Number 09/723,020) which shows the same attorney docket number, namely 18393-12, as is listed in Exhibits 3 and 4¹. Thus, Exhibits 3 and 4 corroborate the Supplemental Declaration in showing the association between the letters and the present application.

Finally, the Examiner states that the Exhibits show "no diligence at all". However, the Applicant has presented a prima facie showing under 37 C.F.R. Section 1.131 as set forth in the Supplemental Declaration and in the 4 Exhibits that clearly show the contrary. For example, Exhibit 1 corroborates the statements of the Supplemental Declaration that the claimed invention was conceived by the Applicant as least as early as February 4, 2000. Further, Exhibit 2 corroborates that the claimed invention was actually reduced to practice at least as early as August 11, 2000. Exhibits 3 and 4 clearly show that the Applicant's attorneys exercised diligence to draft, revise and finalize the

¹ Exhibits 3 and 4 have been redacted due to the content of these letters being subject to the attorney/client privilege which the client has not waived. In addition, actual copies of the draft applications have been withheld from Exhibits 3 and 4 due to their confidential nature and the resulting loss of that confidential status that would otherwise result in this public proceeding.

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application and then constructively reducing to practice the invention by filing the application with the USPTO.

In view of the foregoing, it is submitted that the record now demonstrates the prior concepts and reduction to practice of the claimed invention. The Applicant thus respectfully requests that the Examiner reconsider the finding that the above-discussed Exhibits are inadequate to swear behind the *McManus et al.* application.

Claim Rejections 35 U.S.C. § 102

Claims 1, 11, and 19 are rejected under 35 U.S.C. § 102(e) as being anticipated by *McManus et al.* As discussed above, the Applicant has submitted a Supplemental Declaration of Raymond Blodgett, Jr. (the inventor) under 37 CFR § 1.131 swearing to a conception date for the present invention of at least as early February 4, 2000, an actual reduction to practice date of at least as early as August 11, 2000, a constructive reduction to practice date of November 27, 2000 and diligence between all dates.

Accordingly, it is submitted that the *McManus et al.* reference can no longer be properly relied upon as prior art to the claimed invention. Hence, the Applicant respectfully requests the withdrawal of the rejection of claim 1 based on the *McManus et al.* reference and an indication of allowability thereof.

Claims 2, 6-14, and 20-25 are also rejected under 35 U.S.C. § 102(e) as being anticipated by *McManus et al.* These claims depend from claim 1 and thus for at least the reasons stated as to claim 1 are also allowable. However, these claims further limit the claimed invention and thus are separately patentable.

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Claim Rejections 35 U.S.C. § 103

Dependent claims 3, 4, 5, 15-18 and 26 stand rejected under 35 U.S.C. § 103 on the *McManus et al.* reference alone or in combination with *Smith* or *Schneider*. In this regard, and as stated above, in view of the Supplemental Declaration of Raymond Blodgett, Jr. Under 37 CFR § 1.131, the *McManus et al.* reference can no longer be properly relied upon as prior art to the claimed invention. Hence, the Applicant respectfully requests the withdrawal of the rejection of these claims and an indication of allowability. However, it is noted that these dependent claims further limit the claimed invention as thus are patentable over and above their precursor independent claims.

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Conclusion

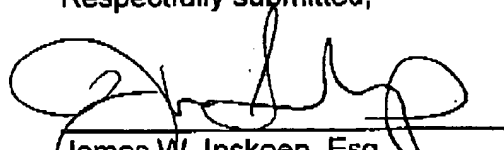
In view of the foregoing, it is submitted that all claims after entry of this amendment are in condition for allowance.

If any questions or issues arise that are more easily addressed by the Examiner through direct communication with the undersigned, the Examiner is cordially to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: July 27, 2005


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